

providing the first and second trim parts, the first trim part having a mating surface configured to lie alongside a mating surface of the second part when the first and second trim parts are supported adjacent one another;

forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part;

providing buffer material in the recess and overfilling said recess so as to provide a bead of buffer material on the mating surface of the first trim part;

allowing the bead to mechanically connect to the first trim part by hardening of the buffer material within the recess; and

supporting the first and second trim parts adjacent one another with the second trim part contacting the bead of buffer material such that the bead is compressed between the first and second trim parts.

REMARKS

Claims 1, 3-11 and 19 remain pending. Claim 1 has been amended. A marked-up copy of the changes made to claim 1 is attached. Claim 19 has been cancelled. The applicants respectfully request reexamination and reconsideration and allowance of claims 1 and 3-11 in view of the amendments above, and remarks below.

More specifically, claim 1 has been amended to recite that the buffer is provided in the recess and overfilling the recess so as to provide a bead of buffer material on the mating surface of the first trim part. Support can be found at page 11, lines 14-18 which recite that the buffer material is extruded into the recess 24 (FIG. 3A) in such a way as

to overfill the recess 24 and provide a bead 12 of buffer material on the mating surface 14 of the first trim panel 16. In addition claim 1 has been amended to recite supporting the first and second trim parts adjacent one another with the second trim part contacting the bead of buffer material such that the bead is compressed between the first and second trim parts. Support can be found in the specification at page 12, lines 11-13 which recites that the second trim panel 52 (FIG. 3A) is installed adjacent the first trim panel 16 such that the bead 12 is sandwiched and compressed between the respective mating surfaces 14, 54 of the trim panels 16, 52. Accordingly, no new matter is believed entered by said amendments.

In the Office Action of October 2, 2001, the Examiner rejected the pending claims under 35 U.S.C. 103(a) over the "admitted prior art" and Reid, Jr. et al (US 5,810,406). The Examiner characterized the "admitted prior art" as that art set forth on pages 1-3 of the instant specification. Applicants herein note as follows.

Looking first at the alleged "admitted prior art", as noted, the Examiner points to pages 1-3 of Applicants specification wherein Applicants pointed out that to reduce labor requirements and improve quality, buffer material in the form of extruded elastomers was extruded onto mating surfaces. The Examiner then correctly noted that the admitted prior art did not teach or suggest the following features of Applicant's invention:

- forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part;

- providing buffer material in the recess so as to provide a bead of buffer material on the mating surface;
- allowing the bead to mechanically connect to the first trim part.

Applicants agree with the Examiner that none of the above features are indeed disclosed or suggested in the admitted prior art. Accordingly, it is worth pausing for a moment to recognize the state of the art regarding the primary reference (i.e., the admitted prior art) relied upon the Examiner. Such art failed to teach or suggest a method for mounting interior vehicle trim parts to reduce noise that made use of forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part, providing buffer material in the recess so as to provide a bead of buffer material on the mating surface, and allowing the bead to mechanically connect to the first trim part. In addition, Applicants would now like to add to the above list of features missing from the principal art relied upon by the Examiner, and that would be the feature of overfilling the recess so as to provide a bead of buffer material on the mating surface of the first trim part, and supporting the first and second trim parts adjacent one another with the second trim part contacting the bead of buffer material such that the bead is compressed between the first and second trim parts.

The Examiner therefore turns to Reid et al (US 5,810,406) for the proposition that Reid et al makes up for the deficiencies of the principal art (i.e., the “admitted prior art”). It is respectfully submitted that this is not the case.

Reid '406 discloses trim strips 10 (FIG. 2) that contain an adhesive layer 18, lugs 28, recesses 30, and optionally but preferably an adhesive layer 18. See also, col. 2, l. 46-48. The adhesive layer 18 is clearly positioned remote from the lugs 28 and recesses 30. There can then be no doubt, as the Examiner correctly noted at page 3 of his Office Action of October 2, 2001, that Reid used "a mechanical bond as opposed to adhesive tapes to mate two materials to form an automotive trim", which is the exact quote of the Examiner, with emphasis added.

Therefore, the position of Applicants is as follows. As Reid does not teach or suggest anything remotely resembling a method of reducing noise that makes use of forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part, providing buffer material in the recess so as to provide a bead of buffer material on the mating surface, and allowing the bead to mechanically connect to the first trim part, nor the feature of overfilling the recess, nor the feature that the bead is compressed between the first and second trim parts, it is not seen how Reid et al, in combination with the principal art relied upon by the Examiner, can be said to support a rejection of claim 1 under the provisions of 35 USC 103.

Granted, there can be no doubt that Reid, like a multitude of other references, discloses the advantages of a what can reasonably be described as a basic tongue and groove mechanical engagement. But there also can be no doubt that Reid is absolutely silent on any concern for how to reduce noise between trim parts. In fact, Applicants respectfully submit that Reid et al actually teaches away from Applicants' invention, in the sense that Reid et al positions his adhesive 18 remote from the location

of mechanical engagement of lugs 28 into recesses 30. In that regard, even if one should assume that Reid et al's adhesive qualifies as a "buffer material", it is noteworthy that Reid et al teaches that one should **not** introduce such buffer material between the two mating surfaces 18 and 30.

In that regard, why Reid et al would be so unconcerned with noise produced from any relative motion between mechanically engaged parts, in a vehicle, emerges as a central but nonetheless relatively easy question to answer. Reid et al is primarily focused on the manufacture of a "trim strip" (see item 10 in Fig. 1) which is placed on the vehicle exterior. In addition, Reid et al discloses a trim strip 110 in Fig. 3 for use as a "refrigerator seal". Col. 3, l. 26-32. Issues of reducing noise such as buzzes, squeaks or rattles due to relative motion of mating surfaces, through the use of a buffer of any sort, was therefore (and quite logically) not a concern of Reid et al. Accordingly, carefully considered, Reid et al can not be properly characterized as a reference which even recognized the problem of noise reduction identified by Applicants, much less its solution. *In re Shaffer*, 43 C.C.P.A. 758, 229 F.2d 476, 480, 108 U.S.P.Q. (BNA) 326, 329 (CCPA 1956) (references which never recognized applicant's problem would not have suggested its solution).

Furthermore, Applicants would like to make one additional observation, and that was the Examiner's conclusion at page 3 of the Office Action of October 2, 2001 that "it would have been obvious to one of ordinary skill in the art at the time the invention

was made to apply the above teachings of Reid et al to the admitted prior art in order to overcome the problem of bonding elastomer to the various materials of the interior trim of automobiles."

First, in order to sustain a rejection under 35 USC 103, it is incumbent upon the Examiner to show that, based upon the prior art, the claimed invention would have been obvious to one of ordinary skill in the art. MPEP 2143 (the prior art references, or references when combined, must teach or suggest all the claim limitations); MPEP 2143.03 (to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art). Applicants therefore respectfully submit that on procedural grounds alone, the Examiner's conclusion that the art of record would have "overcome the problem of bonding elastomer to the various material of the interior trim of automobiles" does not support a 35 USC 103 rejection of the combined limitations of claim 1.

Furthermore, Applicants respectfully disagree that the prior art relied upon by the Examiner, would, in fact, have led one to overcome the problem of bonding elastomer to the various materials of the interior trim of automobiles. Indeed, it is the present invention, through its disclosure and recitation of

forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part, providing buffer material in the recess so as to provide a bead of buffer material on the mating surface, and allowing the bead to mechanically connect to the first trim part, and the

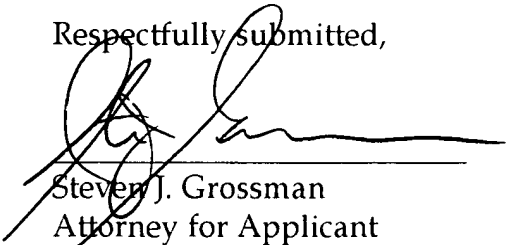
overfilling the recess, and the use of a bead that is compressed between the first and second trim parts,

that one now can consider the use of a bead of a single buffer material between adjacent parts even where the parts have differing material compositions. See the specification at page 2, l. 30 to page 3, l. 2. Accordingly, nothing exists in the "admitted prior art" or Reid et al that remotely identifies the problem of reducing noise and the associated problem of bonding dissimilar materials, much less the claimed solution presented herein by the Applicants.

It is respectfully submitted, therefore, that the rejection of claim 1 under 35 U.S.C. 103(a) as being obvious, should be withdrawn upon reconsideration. Claims 3-11 depend directly or ultimately, from independent claim 1 and must be construed to include all of the limitations of claim 1. Accordingly, claims 3-11 are believed allowable for the reasons discussed above with respect to independent claim 1, in addition to their own additional limitations. It is respectfully submitted, therefore, that the rejection of claims 3-11 under 35 U.S.C. 103 as being unpatentable, should also be withdrawn upon reconsideration.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,


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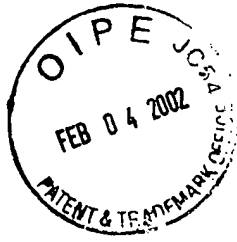
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By Kevin J. Stearns

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Marked Copy of Claim Changes

Serial No. 09/322,585

Docket: TRM P2590.1

1. (Thrice Amended) A method for mounting interior vehicle trim parts to reduce noise in which a first trim part is supported adjacent a second trim part and in which a bead of buffer material is provided between the first and second trim parts to reduce noises [such as buzzes, squeaks and rattles that might otherwise be] produced by contact and relative motion between the first and second trim parts the method including the steps of:

providing the first and second trim parts, the first trim part having a mating surface configured to lie alongside a mating surface of the second part when the first and second trim parts are supported adjacent one another;

forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part;

providing buffer material in the recess and overfilling said recess so as to provide a bead of buffer material on the mating surface of the first trim part;

allowing the bead to mechanically connect to the first trim part by hardening of the buffer material within the recess; and

supporting the first and second trim parts adjacent one another with the second trim part contacting the bead of buffer material such that the bead is compressed between the first and second trim parts.